REMARKS

Upon entry of this Response, claims 1, 4-9, and 11-16, and 18-28 remain pending in the present patent application. Claim 16 has been amended, and claims 17 and 21-26 have been canceled. Applicants request reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action, claims 1, 4, 6, 7, 9, 11, 13, 15-18, 20-23 and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication 2002/0073304 A1 filed by Marsh et al. (hereinafter "*Marsh*"), in view of U.S. Patent 6,516,346 issued to Asco et al. (hereinafter "*Asco*"), and further in view of U.S. Patent 6,742,025 issued to Jennery et al. (hereinafter "*Jennery*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants assert that the rejection of the above-mentioned claims is improper. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, claim 1 provides as follows:

1.   A computer system, comprising:
a central processor unit (CPU);
a programmable read only memory (ROM) coupled to said CPU, said ROM containing a digital image;
wherein said CPU programs its ROM during a system initialization, wherein the system initialization further comprises a booting of said system;
a connection to a network and wherein, during the system initialization, said system sends a message to a server coupled to the network to determine whether an upgraded image is available for said ROM; and
wherein, during the system initialization, said system receives an upgraded image and flashes said ROM with the upgraded image if the upgraded image is available for said ROM.

With respect to claim 1, the Office Action states in part:

"Marsh and **Asco** disclose the system as described above. But **Marsh** and **Asco** does not expressly disclose "..."...*during the system initialization, system sends a message to a server coupled to the network ...*". However **Jennery** discloses:
"...*during the system initialization, said system sends a message to a server coupled to the network...*" (E.g., see Figure 8A (72) & Column 13, lines 36-39), wherein the system (network device), during system initialization, sends or forwards a message (trigger data) to a server coupled to a network.

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"...*during the system initialization, said system receives an upgraded* ..." (E.g., see Figures 8A (76) & Column 3, lines 39-44), wherein the system (network device), during system initialization or boot sequence, receives (trigger data) from a server coupled to a network." (Office Action, pages 5-6).

Applicants respectfully disagree. Specifically, *Jennery* fails to show or suggest the concept of receiving an upgraded image and flashing a ROM with the upgraded image if the upgraded image is available for the ROM during the system initialization. In particular, at column 10, line 43 - column 11, line 12, *Jennery* states:

> FIGS. 8A-B illustrate a flow chart of one embodiment of a method for updating data 38 during loading of an operating system into memory 20 of network device 12 (i.e., during an operating system boot sequence). As described above, execution of boot sequence instructions causes CPU 18 to load an operating system, and at least a portion of operating system data 40, into memory 20 of network device 12. CPU 18 then executes operating system instructions with memory 20. In the embodiment of FIGS. 8A-B, the boot sequence includes a first portion "portion #1" and a second portion "portion #2". CPU 18 performs the first portion of the boot sequence before the second portion. During a step 70, network device 12 performs the first portion of the boot sequence "portion #1".
>
> Trigger data is forwarded from network device 12 to server 14 as described above during a step 72. During a step 74, network device 12 performs the second portion of the boot sequence "portion #2" while server 14 simultaneously generates action data. A particular method for generating the action data will be described in detail below. The action data generated by server 14 is conveyed from server 14 to network device 12 as described above during a step 76.
>
> Client synchronization service module 42 of network device 12 analyzes the action data during a decision step 78. If the action data includes no data update instructions, data 38 is up to date (i.e., synchronized with data 50), and no further action is required. On the other hand, if the action data includes at least one data update instruction, data 38 is "out of date" and must be updated.
>
> During a step 80, client synchronization service module 42 performs the data update instructions of the action data. Client synchronization service module 42 then generates update data as described above, and forwards the update data from network device 12 to server 14 during a step 82. Following step 82, the boot sequence is restarted with step 70.

As set forth above, the only action that takes place during the initialization of the computer is that a trigger is transmitted from the computer to a server in the middle of execution of first and second portions of an operating system on the

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device. The updates are then downloaded after a full initiation occurs and then, thereafter, the boot sequence is restarted.

In contrast, the present system flashes the ROM and installs an upgraded image before the system initialization has ended. This is advantageous, as no reboot of the system is necessary.

Accordingly, Applicants assert that the rejection of claim 1 is improper. Therefore, Applicants request that the rejection of claim 1 be withdrawn. In addition, Applicants request that the rejection of claims 4, 6, and 7 be withdrawn as depending from claim 1. In addition, Applicants request that the rejection of claims 9 and 16 be withdrawn for the same reasons described above with respect to claim 1. Also, Applicants request that the rejection of claims 11, 13, 15, 18, and 20 be withdrawn as depending from either claim 9 or claim 16.

In addition, it is noted that claims 17, and 21-26 are canceled herein, thereby rendering this ground for the rejection moot with respect to such claims.

Next, in item 17 of the Office Action, claims 5, 12, 19, 24, and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Marsh, Asco and Jennery* as applied to claim 1, and further in view of U.S. Patent 6,594,757 issued to Martinez (hereafter "*Martinez*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP 2143.03, *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). Applicants respectfully request that the rejection of claims 5, 12, and 19 be withdrawn as ultimately depending from either claim 1 or claim 9 for the reasons described above with respect to such claims. In addition, Applicants note that claims 24 and 25 have been canceled herein, thereby rendering this ground for rejection moot with respect to such claims.

In addition, in item 23 of the Office Action claims 8 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Marsh, Asco,* and *Jennery* as applied to claim 1, and further in view of U.S. Patent 6,009,524 issued to Olarig et al. (hereafter "*Olarig*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP 2143.03, *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). Applicants respectfully request that the rejection of claims 8 and 14 be withdrawn as depending from claims 1 and 9 for the reasons described above with reference to claims 1 and 9.

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In addition, claim 27 had been previously amended to provide as follows:

27.   An enterprise computing system, comprising:
a plurality of computers, each having a programmable ROM;

a proxy enterprise ROM server to which the computers couple, said proxy enterprise ROM server communicating with a network external to the enterprise; and

wherein said proxy enterprise ROM server includes a first storage area for an untested ROM image update, and a second storage area for an approved ROM image update, and at least one of said computers, during its initialization, checks the second storage area for the approved a ROM image update to be installed in the at least one of said computers, wherein the approved ROM image update comprises the untested ROM image update that has undergone at least one suitable approval test.

With respect to claim 27, the Office Action states in part:

"But, **Marsh, Asco and Jennery** do not expressly disclose "...*includes a first storage area for an untested ROM image update, and a second storage area for an approved ROM image update ...*" or "...*checks the second storage area for approved ROM image update to be installed in the at least one of said computers, wherein the approved ROM image update comprises the untested ROM image update that has undergone at least one suitable approval test...*". However, it would have been obvious to one of ordinary skill in the art, to test the upgrade before deploying it. It would have been obvious because it is old and well known in the art that before an upgrade or revision is issued for deploying it should be tested. Therefore it would have been obvious to include a first storage area for an untested ROM image update and to install the tested upgrade image as is well known in the art." (Office Action, pages 14-15).

Applicants respectfully disagree. In particular, the delineation of storage areas for tested and untested ROM images allows an administrator to properly ensure that the local area network computers are properly configured and will not experience failures. This also allows them to perform testing without computers in the network being updated with the software that has not been tested first.

While it is known that software is tested, Applicants assert that in a particular environment created for the testing of ROM images and storage ROM images for testing and for actual updating as claimed is not shown or suggested. In this respect, the Office Action does not cite a particular reference as showing or suggesting the respective elements mentioned above of claim 27 in support of the

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rejection. Accordingly, Applicants assume that such elements recited above have been rejected in view of the personal knowledge of the Examiner.

When a rejection in an application is based on facts within the personal knowledge of an Examiner, it should be as specific as possible. When called for by the Applicants, the Examiner must support the assertion with an affidavit, which is subject to contradiction or explanation by the affidavits of the Applicants or other persons 37 C.F.R. §1.104(d)(2).

Accordingly, Applicants hereby request an affidavit attesting to the personal knowledge of the Examiner as to the elements of claim 27 in question or that a proper reference be cited to support the rejection. Otherwise, Applicants request that the rejection of claim 27 be withdrawn. In addition, Applicants request that the rejection of claim 28 be withdrawn as depending from claim 27.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

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